

Application No.: 08/468,437  
Amendment dated September 24, 2003  
Reply to Office Action of July 24, 2003

## **REMARKS/ARGUMENTS**

### **Status Of Application**

Claims 20-22, 33, 34, and 40-50 are pending in the application; the status of the claims is as follows:

Claims 1-19, 23-32, 35-39, and 51 were previously cancelled.

Claims 41, 43-46, and 50 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 20-22, 33, 43, 44, and 47-50 (incorrectly stated in the Office Action as claims 20-30, 33, 43, 44, and 47-50) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication No. (A) 64-47177 to Okamoto ("Okamoto") in view of U.S. Patent No. 5,034,804 to Sasaki et al ("Sasaki").

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Okamoto in view of Sasaki as applied to claim 20 above, and further in view of U.S. Patent No. 4,937,676 to Finelli et al ("Finelli").

Claims 40-42, 45 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okamoto in view of Sasaki and U.S. Patent No. 5,162,833 to Taka ("Taka").

Claims 20 - 50 are herein cancelled.

### **35 U.S.C. § 112 Rejection**

The rejection of claims 41, 43-46, and 50 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which Applicants regard as the invention, is respectfully traversed based on the following.

Claims 41, 43-46, and 50 have been cancelled herein. Thus, the rejection of these claims under second paragraph of 35 U.S.C. § 112 is moot.

### **35 U.S.C. § 103(a) Rejections**

The rejection of claims 20-22, 33, 43, 44, and 47-50 under 35 U.S.C. § 103(a), as being unpatentable over Okamoto in view of Sasaki, is respectfully traversed based on the following.

Claims 20-22, 33, 43, 44, and 47-50 have been cancelled herein. Thus, the rejection of these claims under 35 U.S.C. § 103(a), as being unpatentable over Okamoto in view of Sasaki, is moot.

### **New Claims**

New claims 52- 63 have been added to provide a more adequate basis of protection of the invention. No new matter was added.

New claim 52 is directed to a camera having an inside memory and a card slot adapted to receive a memory card. If the memory card is inserted into the card slot, image information is stored in the memory card. A detector detects a capacity of the memory of the inserted memory card. If the detector determines that image information cannot be stored on the memory card inserted into the card slot, a warning is displayed even if the image information can be stored in the inside memory.

New claim 53 is directed to a camera having an inside memory and a card slot adapted to receive a memory card. If the memory card is inserted into the card slot, image information is stored in the memory card. A detector detects a capacity of the memory of the inserted memory card. If the detector determines that image information cannot be

stored on the memory card inserted into the card slot, the image information is stored in the inside memory, and a warning is displayed even if the image information can be stored in the inside memory.

New claim 54 is directed to a camera in which image information can be stored both in a memory card and in an inside memory. If the memory card is inserted, image information is stored in the memory card. If the remaining capacity of the inserted memory card is insufficient, a warning is displayed even if the remaining capacity of the inside memory is sufficient.

New claim 55 is directed to a camera in which image information can be stored both in the memory card and the inside memory. If the memory card is inserted, image information is stored in the memory card. If the remaining capacity of the memory card is insufficient, image information is stored in the inside memory, and a warning is displayed even if the remaining capacity of the inside memory is sufficient.

Okamoto discloses a mounted memory (14) and an external memory (2), which is an external storage device to be connected to the camera via a cable. However, in Okamoto, the external memory is not a memory card which is detachably inserted in the card slot of the camera. Further, Okamoto recites an arrangement in which image information is stored in the mounted memory (14) and then switched to the external memory (2) after completion of the information storage. Accordingly, Okamoto requires both the mounted memory (14) and the external memory (2) for storage of image data. Okamoto does not disclose or suggest storing image data in a memory card only if the memory card is inserted into the camera. Additionally, Okamoto does not disclose or suggest providing a warning if the detector determines that image information cannot be stored on the memory card, even if the image information can be stored in the inside memory.

Sasaki assertedly discloses a digital camera using a removable memory card. Image output from the camera is transferred from image capture circuitry to buffer

memory and then transferred to a memory card. While Sasaki discloses storing image data on a buffer memory prior to storage in the removable image card, this memory is only a buffer memory and will not retain the image information if the image information cannot be stored in the memory card. Thus, Sasaki does not disclose or suggest an inside memory which stores image information if the image information cannot be stored in the memory card. Further, Sasaki does not disclose or suggest displaying a warning if the detector detects that image information cannot be stored in the memory card, even if the image information can be stored in the inside memory.

Finelli is cited in order to overcome the above illustrated inadequacies of Okamoto and Sasaki. Finelli is cited as teaching providing a printer in a camera apparatus. Finelli recites an arrangement in which a storing condition is selectable between a condition in which image information is stored in a storage device by mounting the storage device on the camera main body and a condition in which image information is stored by way of a printer by electrically connecting the camera to the printer. However, Finelli fails to disclose or suggest switching between storage on an inside memory and a memory card. Further, Finelli fails to disclose or suggest providing a warning if the detector detects that image information cannot be stored in the memory card, even if the image information can be stored in the inside memory.

Taka is cited in order to overcome the above illustrated inadequacies of Okamoto and Sasaki. Taka is cited as teaching a camera having a first memory and a second memory for storing image information from an image pickup device and a means for selecting either one of the memories to reproduce image information. While Taka discloses that a camera has two kinds of memories, i.e., a special memory 12 and a recall memory 10, Taka has no recitation as to whether the special memory or the recall memory is an inside memory or a memory card. Further, the camera of Taka requires that these two memories are both necessary in any condition. Accordingly, Taka is silent about switching between storing in the inside memory and the memory card. Further, Taka is silent regarding providing a warning if the detector detects that image information cannot

be stored in the memory card, even if the image information can be stored in the inside memory.

With respect to claim 52, none of the cited art, (i.e., Okamoto, Sasaki, Taka, and Finelli), either singly or in any combination thereof, discloses or suggests providing a warning which displayed, even if the image information can be stored in the inside memory, if the detector determines that image information cannot be stored on the memory card inserted into the card slot. Accordingly, claim 52 is allowable over the cited art, either singly or in any combination thereof.

With respect to new claim 53, none of the cited art, (i.e., Okamoto, Sasaki, Taka, and Finelli), either singly or in any combination thereof, discloses or suggests that if the detector determines that image information cannot be stored on the memory card inserted into the card slot, the image information is stored in the inside memory, and a warning is displayed even if the image information can be stored in the inside memory. Accordingly, claim 53 is allowable over the cited art, either singly or in any combination thereof.

With respect to new claim 54, none of the cited art, (i.e., Okamoto, Sasaki, Taka, and Finelli), either singly or in any combination thereof, discloses or suggests switching between storage on the inside memory and the memory card. Further, none of the cited art, either singly or in any combination thereof, discloses or suggests providing a warning which displayed, even if the remaining capacity of the inside memory is sufficient, if the remaining capacity of the inserted memory card is insufficient. Thus, claim 54 is allowable over the cited art, either singly or in any combination thereof.

With respect to new claim 55, none of the cited art, (i.e., Okamoto, Sasaki, Taka, and Finelli), either singly or in any combination thereof, discloses or suggests switching between storage on the inside memory and the memory card. Further, none of the cited art, either singly or in any combination thereof, discloses or suggest providing a warning which is displayed, even if the remaining capacity of the inside memory is sufficient, if the

remaining capacity of the inserted memory card is insufficient. Thus, claim 55 is allowable over the cited art, either singly or in any combination thereof.

Claim 56 depends from and further limits new independent claim 52. Claim 57 depends from and further limits new independent claim 53. Claims 56 and 57 recite wherein the detector includes a memory capacity detector for detecting the capacity of the memory card by electrically accessing the memory card, and a card switch for detecting whether or not the memory card is inserted in the card slot. None of the cited references, either singly or in combination, discloses or suggests this limitation. Thus, claims 56 and 57 are allowable over the cited references, either singly or in combination.

Claim 58 depends from and further limits new independent claim 54. Claim 59 depends from and further limits new independent claim 55. Claims 58 and 59 recite wherein the detector includes a memory capacity detector for detecting the remaining capacity of the memory card by electrically accessing the memory card, and a card switch for detecting whether or not the memory card is inserted in the card slot. None of the cited references, either singly or in combination, discloses or suggests this limitation. Thus, claims 58 and 59 are allowable over the cited references, either singly or in combination.

Claims 60 depends from and further limits new independent claim 52. Claim 61 depends from and further limits new independent claim 53. Claims 60 and 61 recite wherein the changer determines to change from a condition in which the memory card is used to store the image information to a condition in which the inside memory is used to store the image information, when the memory card is inserted in the card slot, and the detected capacity shows that the image information cannot be stored in the memory card. None of the cited references, either singly or in combination, discloses or suggests this limitation. Thus, claims 60 and 61 are allowable over the cited references, either singly or in combination.

Claims 62 depends from and further limits new independent claim 54. Claim 63 depends from and further limits new independent claim 55. Claims 62 and 63 recite

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wherein the changer determines to change from a condition in which the memory card is used to store the image information to a condition in which the inside memory is used to store the image information, when the memory card is inserted in the card slot, the remaining capacity detected by the detector is insufficient and the remaining capacity of the inside memory is sufficient. None of the cited references, either singly or in combination, discloses or suggests this limitation. Thus, claims 62 and 63 are allowable over the cited references, either singly or in combination.

Accordingly, Applicants respectfully assert that new claims 52-63 are considered in condition for allowance. Prompt allowance of these claims is respectfully requested.

#### CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.


Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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